



Examiner Thein  
Serial # 10/025,957

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### **REMARKS/ARGUMENTS**

Reconsideration and allowance of the application as amended is respectfully requested.

#### ***Summary of Changes:***

1. Claims 1 and 19 have been modified to include the collection of demographic information. Support for this amendment is found in paragraphs 37 and 38 of the application as filed. These amendments add no new matter to the specification and acceptance of these amendments is respectfully requested.
2. It is respectfully submitted that the claims of the present application are now allowable in view of these amendments.

#### ***Remarks:***

3. The Examiner has rejected claims 1,5,8-9 and 13 under 35 USC§103 as being an obvious combination of the features taught in the Robertson and the Slotznick references.
4. Applicant respectfully disagrees with the Examiner's rejection for the following reasons:
5. In order to present a prima facie case of obviousness, the Examiner is required to show that a person of ordinary skill in the art at the time that the invention was made would have been taught and motivated by the prior art referenced to combine the references in the way that the inventor has done. This includes a requirement that a reason for combining the references existed at the time that the combination was made and that the teachings of the prior art taught that making the outlined combination would be successful. Furthermore, the combination which is set forth by the Examiner must include each and every element which is set forth in the claims of the application.
6. Applicant respectfully submits that the Examiner has not presented such a case. From the rejections viewed in the Office Action it appears that the Examiner has viewed the claims as a blueprint and has assembled references in an attempt to produce a combination that includes each and every feature which has been set forth in the claims.
7. There is no motivation, suggestion or invention in the prior art to do what the inventors of the present invention have done. Particularly, there is no motivation to combine the method of the Slotznick and the Robertson references.
8. Both the Slotznick and the Robertson references are directed to opposing and completely different actions and each are complete in and of themselves. The Slotznick reference is directed

for a self activating method whereby a computer system accomplishes a variety of predetermined tasks, such as purchasing flowers, groceries, making travel plans etc. according to a pre-selected set of criteria from a preselected group of items. The Robertson reference is directed to the mechanization of a simple bridal or maternity shower list wherein a party that is to receive the gifts, preselects the gifts that they would like to receive, and other parties can select these gifts.

9. The Robertson reference simply teaches the presenting of a pre-selected list of preselected gifts to a potential purchaser. These gifts have been preselected by the person who is to receive them and there is no system or need for presenting items based upon a particular preference, interest, or other characteristic of the user. In fact there is no need for such information because the items that are to be purchased have already been preselected.

10. The Slotznick reference teaches a method for performing simple tasks and purchasing selected items according to a particular schedule or command. The Robertson device simply displays a list of items for purchase by a consumer. The aims of these items are distinct and opposed.

11. The Slotznick reference is intended to remove a user from having to make purchases and instead requires that a selection only needs to be made once and then the pattern related to the fulfilling of this action will continue there after. The Robertson reference is intended to place the purchaser in control of making these purchasing decisions. Because the aims of the two inventions are opposed, combining the references would require that the aim of one of the references would have to be overlooked in favor of the other. However the prior art does not teach which of the two aims and methods should be heeded and which should be ignored. Therefore, there is no motivation or suggestion to combine the references because the aims of the two inventions are opposed and there is no evidence in the prior art that the aims of one of the two inventions is preferable to the aims of the other.

12. Furthermore, even if combined there is no indication that such a combination would be successful. This is due in part to the fact that the ends of the two inventions are opposed.

13. In addition, this combination of the Slotznick and the Robertson references fails to teach all of the features which are present in the present application and which are set forth in the claims. The Robertson reference does not teach the sorting of items based upon preferences and demographic information as has been claimed in the present invention. The Robertson reference merely teaches the inclusion of a list of items that had been previously selected by a potential gift recipient. While one could construe this as being a "preference or interest" of the gift, it is merely a selection from a list which was done previously by the potential gift recipient and does not take into consideration other factors which the present invention does.

14. In column 2, lines 55 through 58 of Robertson, the patent states that "the major benefit to

the individual is that they can store a complete “Wish” list of all items of interest in a central location that others may access for gift purchases and do so in a faster method than previous inventions.”

15. In column 10, lines 3 through 7, Robertson states that “the Service Provider maintains a list of items of interest on behalf of the user and allows the user to either purchase these items or have them transferred to the on-line gift registry to be added to the user’s Wish list.” In column 10, line 42, the system of Robertson is compared with existing systems and in item 2, it is stated that “the user is able to tag items of interest while shopping at SP sites and have the SP transfer the items to their centralized “Wish” list on their behalf.” And at #6 in the same page, column 10, line 50-56, purchasers can “filter items in the registrant’s “Wish” list based on different criteria such as re-seller and costs among others.”

16. All explanations of the Robertson system indicates that the user selects specific items to be placed in his “Wish” list. This is different than the system of the invention. In the system of the invention the user would typically not specify specific products. Rather, they would specify general information such as interest in hobbies, interest in certain types of products, an income bracket, a geographic location, interest in certain types of products for certain gift recipients, such as a spouse, and other things which generally but not specifically indicate to the system what types of product should be presented and when they should be presented. When the products are presented to the user, they fit the general interest of the user. They might be hiking equipment, ski clothes, jewelry in the price range of \$100 - \$150, business software, history books, or other items that fit the general profile that the user has supplied. These can include items for a spouse or presents for other people which might include jewelry, flower arrangements, articles of clothing from various manufactures, etc. None of these articles are specifically selected by the user. Rather they are selected by the system based on the merchant submissions and the user’s interest and preferences, price range and age. Thus, the gift registry of Robertson is different than the product selections and presentation system of the current invention. Claim 1 has been modified to further highlight these differences, and differentiate claim 1 more clearly from the invention of Robertson.

17. Claims 2, 4, 6-7, 10-12, and 14-18 are rejected under 35 U.S.C. §103(a) as being patentable with Robertson combined Slotznick et al as applied above, when further combined with U.S. Pat. No. 5,991,771 to Falls, et al.

18. In addition to the aforementioned deficiencies, the combination of the Fall reference again fails to teach a person of skill in the art how to modify these references so as to obtain the present invention.

19. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j).

20. There is no motivation whatsoever provided by Robertson, Slotznick and/or Falls to provide a system like that of the present invention. Each of these patents are complete and solves a particular problem, whereas a different problem is solved by the system of the invention. The combination of Robertson and Falls is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicant's claims.

21. In particular, the references do not disclose, teach or suggest a system whereby merchants can present items or services to a shopper based on the shoppers interests, preferences, characteristics, and in a way that the shopper can interact with the product offering while offline.

22. To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.* 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

23. Falls, et al., is a file protocol in which two computers are linked together and files on the system computer are downloaded to the portable computer. The files downloaded are part of a database, and the system manager would determine which portions of the database structure would be transferred to the portable computer. The user can then disconnect his portable computer and work on the data as if he were still connected to the system computer. Thus, the portable computer presents a virtual network to the user. When the user reconnects his portable computer to the system computer, the files are synchronized and any changes made by the user are updated to the system files.

24. With this updating capability between a base computer and a portable computer, the system of Falls, et al., is similar to the updating capability of a Palm Pilot. With a Palm Pilot or other PDAs, the information between one computer and another, or between multiple computers, is updated by a process called "hot syncing." Thus, the changes made on a desktop computer at work are transferred to the hand-held PDA and the address list for instance of the PDA is updated. When the PDA is synchronized with the home computer, the home computer is also

updated with the most current information. This appears to be what Falls, et al., achieves with his patent.

25. As with updating a Palm Pilot, Falls, et al., refers to computers which are disconnectable from the system, but which include a database manager (Col. 7, Lines 16-19). Falls, et al., later notes that “replicas 56 at different locations (namely on separate computers 40) may temporarily contain different values for the same variable or record.” Such inconsistencies are temporary because changes in value are propagated throughout the replicas by the invention. Thus, if the changes to a particular variable or record are infrequent relative to the propagation delay, then all replicas 56 will converge until they contain the same value for that variable or record (Col. 7, Lines 44-53).

27. The system described above is equivalent to updating information between a Palm Pilot and a work computer or home computer. Falls, et al., refers to “syncupdate requests” and the “replicas being resynchronized” in a manner very consistent with this synchronization of databases between a Palm Pilot and a computer.

28. However, this synchronization activity is not the same as the updating of information step of the system of the invention. In the synchronization program of Falls, et al., duplicate databases are updated to reflect current changes entered by the user. The purpose of the update is to keep the database information identical in each platform. They are not updated with information to be fed to the user which is generated based on the user’s interest and preferences and those of his gift recipients. Further, there is no suggestion in Falls, et al., to combine the database updating function with a product presentation software. Thus, there is no suggestion to combine Falls, et al., with Robertson or Slotznick. Falls, et al., is complete as it is, and is provided to synchronize information in databases between the system and computers which are disconnected from the system.

29. The Examiner has rejected claim 3 under 35 U.S.C. §103(a) over Robertson, and Slotznick as described above in further view of Woolston, U.S. Pat. No. 6,202,051. Claim 3 adds a feature to the capabilities described in claim 1, that feature being responding to product postings in the form of an auction.

30. As described previously, the combination of the Slotznick and the Robertson references is insufficient and lacking in appropriate sufficiency and detail so as to be able to support an obvious type rejection.

31. Woolston is a patent for an on-line auction which appears to be an on-line auction as exemplified by the famous on-line auction, Ebay. The Examiner states that combining the on-line auction capability of Woolston with the gift registry patent of Robertson, is basically equivalent to claim 3. However, there is nothing in the Woolston patent to indicate any

desirability or capability of linking with a gift registry, and further, the gift registry of Robertson is not at all analogous to the system of the invention which is a system which acts as a personal assistant to a subscriber. The personal assistant function of this system comes in play when products are presented based on a user's interest and preferences, for himself or for people on his gift list. There is nothing in Robertson or Woolston, or the combination of the two to suggest this capability.

34. The Examiner has rejected claim 19 under 35 U.S.C. §103(a) over Robertson combined with Slotznick, Falls, et al., and Woolston, and the teachings of the article "Reminder/Gifted Solutions announces Merchants and Portal Partners Using its New Gift Services Engine at Internet Commerce Expo this Week." These patents have been described above, and article adds little support further assist in this rejection. This rejection has two flaws. There is no suggestion in any of these inventions to combine with other inventions to achieve the purpose of the current invention. Furthermore, even if they were combined, none of these patents have the basic functionality of the current invention.

35. The Examiner notes that Slotznick in Col. 18, Lines 36-58 discloses an information gathering system for gift profiles. This text in Slotznick cited by the Examiner is a description of how the first embodiment of the invention would work. That embodiment was "send flowers to Jim Smith and his wife on their anniversary." Accomplishing this task is described in Slotznick in Col. 18 starting at Line 7. In this example, the user has already chosen the type of gift, and that is going to be flowers. After entering information about whom the recipients are going to be ("Jim Smith and his wife"), the device may automatically complete the name. The user then enters the occasion for the gift (Col. 18, Lines 47-48) and lastly, the system can enter the address automatically and then select the flowers, as described in Col. 18, Lines 36-58.

36. This procedure is different than presenting the user with a number of options relative to an event such as the anniversary of Jim Smith and his wife. With the system of the current invention, the user could be prompted with a range of products which match the general preferences and interests of Jim Smith and his wife. These could include tickets to the opera, flowers, jewelry, articles of clothing, and any number of items which meet general characteristics specified as gift possibilities or areas of interest for Jim Smith and his wife. The system of Slotznick does not provide that kind of product presentation format. By contrast, the current invention puts all of these things together into an integrated system for product presentation and gift reminders.



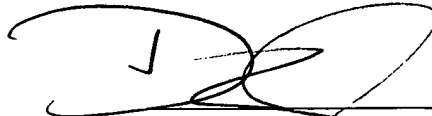
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CONCLUSION

Applicant submits that this application is now in full condition for allowance, which action Applicants respectfully solicit. If the Examiner feels it would advance the application to allowance or final rejection, she is invited to telephone the undersigned at the number given below.

DATED this 14th day of August, 2006

Very respectfully,

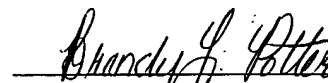
  
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